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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,957	11/18/2003	William H. Davis	032930-005	4586

21839 7590 02/10/2006

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EXAMINER

ROBINSON, KEITH O NEAL

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,957

Applicant(s)

DAVIS, WILLIAM H.

Examiner

Keith O. Robinson, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the 'Remarks' filed on November 14, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The amendments to claims 1, 3, 5-7 and the addition of new claim 33, filed November 14, 2005, have been received and entered in full.

Claims 1-7 and 33 are under examination.

Response to Arguments

2. Applicant's amendments to claim 7, with respect to the 35 U.S.C. § 112, second paragraph rejection of the previous Office Action mailed August 15, 2005 (see pages 4-5), filed November 14, 2005, have been fully considered and are persuasive. The rejection of claim 7 has been withdrawn.

The 35 USC 112, first paragraph rejection of claim 7 for lack of enablement in the Office Action mailed August 15, 2005 has been withdrawn based on Applicant's arguments filed November 14, 2005. Applicant has stated that "the 'WA7824' and 'Zeke' wheat varieties are already known and publicly available" (see page 7, 2nd paragraph of 'REMARKS' filed November 14, 2005).

Claim Rejections - 35 USC § 103

3. Claims 1-6 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,339,184, January 15, 2002) for reasons of record as set forth in a previous Office Action mailed August 15, 2005.

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Applicant argues that the process of Smith requires an initial induced mutagenesis step wherein seeds are subjected to a chemical mutagen (see page 7, second paragraph to page 8, end of last paragraph of 'REMARKS' filed November 14, 2005).

This is not persuasive. The claimed invention is a process for selecting a wheat plant which exhibits genetically-controlled naturally-occurring glyphosate herbicide resistance that is not attributable to genetic engineering consisting essentially of soaking mature wheat seeds that are not genetically engineered for herbicide resistance, planting the wheat seeds following soaking in a growing medium and producing at least one wheat plant, and selecting a wheat plant which exhibits genetically-controlled naturally-occurring glyphosate herbicide resistance not attributable to a foreign gene for herbicide for herbicide resistance introduced by genetic engineering.

Though Smith teaches "an initial induced mutagenesis step", this step is not a genetic engineering step. In addition, the soaking of wheat seeds in a liquid comprising glyphosate herbicide, as is claimed, is an induced mutagenesis step. There is no evidence in the specification that teaches that the wheat seeds that were soaked in the liquid comprising glyphosate herbicide were not genetically altered. Thus, the teaching of Smith is an appropriate rejection under 35 U.S.C. 103, as the 103 rejection states:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made".

As the above statement teaches, Smith does not have to be identical to the claimed invention. The differences between Smith and the claimed invention would have been obvious at the time the invention was made to a person of ordinary skill in the art. Smith teaches a method for selecting a wheat plant that exhibits genetically controlled herbicide resistance that is not attributable to genetic engineering comprising soaking wheat seeds in a herbicide solution, planting said seeds in a growing medium and selecting wheat plants that exhibit genetically controlled herbicide resistance that is not attributable to a foreign gene introduced by genetic engineering (see pages 5-6 of the previous Office Action mailed August 15, 2005). As stated in the previous Office Action, though Smith does not teach the use of glyphosate as an herbicide, it would have been obvious to one of skill in the art to modify the teachings of Smith to produce a method for selecting a wheat plant that exhibits genetically controlled herbicide resistance that is not attributable to genetic engineering based on the success of Smith using AHAS inhibiting herbicide in a method to produce wheat plants that exhibit genetically controlled glyphosate herbicide resistance not attributable to genetic engineering.

Conclusion

4. No claims are allowed.
5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is 571-272-2918. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

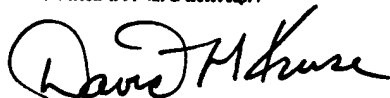
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7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Keith O. Robinson, Ph.D.

January 26, 2006

DAVID H. KRUSE, PH.D.
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "David H. Kruse", written in a cursive style.